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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,257	07/11/2001	Steven M. Cohn	2003034-0002	9439
22204	7590	11/18/2004	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			THEIN, MARIA TERESA T	
		ART UNIT		PAPER NUMBER
				3627

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/903,257	COHN ET AL. <i>S</i>	
	Examiner	Art Unit	
	Marissa Thein	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 August 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-17 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicants' "Amendment" filed on August 19, 2004 has been considered.

Claims 7 and 12 are amended. Claims 1-17 remain pending in this application.

Response to Arguments

Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. The claimed invention must utilize technology in a non-trivial manner. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow

Art Unit: 3627

apply, involve, use, or advance the technological arts. There is no structural or functional interrelationship with these method steps. Therefore, the claim is nothing more than an abstract idea, which is not tied to any technological art and is not a useful art. *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD, Pats. App. & Inter. 2001). See MPEP 2106 IV 2(b).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,592,375 to Salmon et al. in view of U.S. Patent No. 6,629,135 to Boss, Jr. et al.

Regarding claims 1, 7-9, 12-13, and 15, Salmon discloses an apparatus connecting buyers and seller of products and services (brokering goods or services between buyers and sellers) comprising: a comprehensive directory of companies (Product Profile database; Figures 2a-2f); a user maintained database of registered and subscribing companies selected from the comprehensive directory (both buyers and sellers would pay a subscription fee for access to the system; col. 13, lines 62-65); service-brokering tools (Figure 1; a Seller's interface (300), a buyer's interface (500) and database (200)); registering means (both buyers and sellers would pay a subscription fee for access to the system; col. 13, lines 62-65); searching means

Art Unit: 3627

(personal search application; col. 3, lines 58 – col. 4, line 7), based on geographical boundaries (geographical location; Figures 8b); assigning means denoting a weighted importance to provider characteristics (specify “must have” criteria, weighted “want to have” criteria; col. 7, lines 51-54; col. 6, lines 34-45); ordering means for ranking buyers and seller according to the weighted importance of provider (selected products are rank-ordered according to these sums of weights; col. 8, lines 19-24). Furthermore, Salmon discloses means for sharing requests for proposals (see at least col. 8, lines 4-17); a data sharing engine (multimedia database (200)); means for subscription a request brokering engine (both buyers and sellers would pay a subscription fee for access to the system; col. 13, lines 62-65); a request for brokering engine (Figure 1); an object catalog manager (Figure 1; col. 3, lines 48-57); means for a catalog synchronization process (Figure 1; col. 3, lines 48-57). However, Salmon does not disclose the branding means. Salmon discloses brokering transactions between sellers and a buyer of goods and services (abstract).

Ross, on the other hand, teaches an e-commerce outsourcing system that provides hosts with transparent, context sensitive e-commerce supported pages. The host is provided with links correlating the host with a link for inclusion within a pages on the host website; the provided link correlates the host web site with a selected commerce object contextually related to material in the page. (Abstract). Furthermore, Ross discloses the look and fell of each participating Host is captured and stored (col. 3, lines 6-21). Hosts may include links to selected products or product categories within pages residing on the Hosts' website. Upon activation of such a link by a visitor of the

Art Unit: 3627

Host website, a page is presented to the visitor incorporation a replica of the Host's look and feel directed to the sale of the selected products or product categories (branding means).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the apparatus of Salmon, to include the branding means, in order to provide increased marketing potential, incremental sales, and new customer relationships for both the buyers and sellers (Ross col. 2, lines 62-61)

Regarding claims 2-6, Ross discloses an internal mechanism for a web server to infer a private label interface, URL or IP address of a registered and subscribing company; a partner object that can persist and cache the private label interface; the object that can be used to generate private label interface-specific HTML; a mechanism to publish a pending Partner record to an active record and inform all servers with an a qualified farm of load balanced web servers; and a mechanism to synchronize partner information (see at least col. 3, lines 6-57; col. 22, lines 26-54).

Regarding claims 10-11 and 14, 16, Ross discloses a partner management tool; a brand distribution service; a partner-branding framework; a web server with software having encapsulating technologies; programming objects; a template; navigating to a private labeled interface; clicking a registration hyperlink; selecting a subscription package; building a profile of a company; categorizing the provide by selecting main categories and sub-categories; and creating an affiliation (see at least col. 3, lines 6-57; col. 12, liens 41-61; col. 22, lines 26-54)

Regarding claim 17, Salmon discloses the method for connecting buyer and sellers of products and services comprising: maintaining a comprehensive online directory of sellers (Product Profile database; Figures 2a-2f); providing a request for proposal application for integration into a web site (col. 7, lines 47-61); and maintaining a searchable directory of companies (col. 3, lines 49-58). However, Salmon does not disclose the co-branding; e-commerce infrastructure; marketing a private-labeled web site; and providing usage and revenue reports. Salmon discloses brokering transactions between sellers and a buyer of goods and services (abstract).

Ross, on the other hand, teaches an e-commerce outsourcing system (e-commerce infrastructure) and provides hosts with transparent, context sensitive e-commerce supported pages (abstract). The look and fell of each participating Host is captured and stored. Hosts may include links to selected products or product categories within pages residing on the Hosts' website. Upon activation of such a link by a visitor of the Host website, a page is presented to the visitor incorporation a replica of the Host's look and feel directed to the sale of the selected products or product categories (co-branding). Furthermore, Ross teaches revenue summary (revenue reports and usage; col. 8, lines 27-32), and target marketing (marketing, col. 24, lines 26-27).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the apparatus of Salmon, to include the co-branding; e-commerce infrastructure; marketing a private-labeled web site; and providing usage and revenue reports, in order to provide increased marketing potential,

Art Unit: 3627

incremental sales, and new customer relationships for both the buyers and sellers
(Ross col. 2, lines 62-61).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot
November 15, 2004

Michael Cuff 11/15/04
MICHAEL CUFF
PRIMARY EXAMINER